

measured, or 2) the systematic terms and method used to measure the event. The intended meaning of the term **measurement item** is entirely the later, i.e., the systematic terms and method used to assess an observed event.

The References And Differences Of The Present Invention

Prior to discussing the claims, applicant will first discuss the references and the general novelty of the present invention and its unobviousness over the references.

Rindfuss links handwritten notes to a recording through indexes based upon the physical location of the handwriting on a page of paper to the stream of recorded data. The invention uses a touchpad located beneath the paper to acquire spatial location data (based upon a rectangular vector that encloses a segment of writing), further indexed by page number. Each piece of paper is manually placed upon the touchpad and requires manual entry of a page number. When amendments or additions to notes are made, additional index entries are generated and maintained, requiring manual entry of the previous page number if a prior piece of paper is the target of the amendment or addition to the notes. Replay requires manual entry of page numbers and physical contact with the paper in the approximate area of the rectangular vector to generate a touchpad signal that can be used to access the correlated recording. The system is entirely based upon handwritten notes.

Ardis, after a recording and a transcript are generated by standard means, supports an operator in viewing and listening to the recording and examining the transcript and thereby entering timecodes in correlation with elements (e.g., words, passages, lines) from the text transcripts. The use of pre-defined measurement items is not considered or discussed, and Ardis does not focus on generating indexes during the process of observation and assessment but rather during post-processing. Furthermore, during post-processing Ardis does not provide an automated

means of defining segments of recorded material, nor provide an automated means of generating indexes, but rather uses separate software systems requiring laborious manual operation to generate indexes. Text material from transcripts must be searched based upon entered comments, and is subject to a problem of specific comment words being used for more than one indexed timecode, requiring the operator who generates the indexes to keep track of and exercise judgement about the choice of index text markers, which is a serious limitation with lengthy materials. It requires the operator to select what the key word(s) will be. It does not provide a means of handling multiple occurrences of index words ("key words") in the transcript material.

With regard to the use of pre-defined measurement items, applicant performs this for the first time. Until now no one thought of employing pre-defined measurement items as the basis for generating meaningful indexes, much less actually did it. By combining the process of systematic observation and assessment with indexing, valuable time is saved and the usefulness of the indexing is enhanced. As stated, this procedure was not done before, so neither it nor its concomitant advantages were known or appreciated.

The Claims Rejection Under § 102

Claims 1-3, 5-7, 10-11, and 13 were rejected under § 102 being said to have been anticipated by Rindfuss. Applicant requests reconsideration and withdrawal of these rejections.

The Rejection Of Claim 1 On Rindfuss Is Overcome

The O.A. rejected independent claim 1 on Rindfuss. Claim 1 has been rewritten as new claim 14 to define patentability over this reference. Applicant requests reconsideration of this rejection, as now applicable to claim 14, for the following reasons:

- (1) Rindfuss (in col. 1, line 59 through col. 2, line 2) does not disclose a means for presenting a subject or operator with a set of pre-defined event descriptor **measurement items** for use by the subject or operator to structure the observation and assessment of observed events or phenomena. Rather, Rindfuss refers to **events** and **handwritten notes**. Neither of **events** or **handwritten notes** are equivalent to **measurement items**, as referred to in the present invention. Measurement items refer to pre-defined terms and instructions to be used as a tool or instrument for the purpose of systematic and standardized observation and assessment, whereas events are the subject of said observation and assessment. This is entirely foreign to Rindfuss, since handwritten notes are not pre-defined and do not contain instructions to be used as a tool or instrument for the purpose of systematic and standardized observation and assessment. The reference does not teach what the what the examiner relies upon it as supposedly teaching.
- (2) Rindfuss (in col. 2, lines 3-62) does not disclose a means for recording and storing observed events associated with said event descriptor **measurement items** with a data track of event data sequenced by a track of lower-level address data, because Rindfuss does not describe presenting a subject or operator with a **measurement item**.
- (3) Rindfuss (in Abstract and col. 2, lines 3-32) does not disclose a means of automatically generating an index entry in a data base with at least one field denoting a pre-defined event descriptor **measurement item** and associated with recording lower-level address data for associated observed events or phenomena, because Rindfuss does not describe presenting a subject or operator with a **measurement item**.
- (4) Further, Rindfuss does not combine above means in effective real-time to create an integrated observation, assessment, recording, and indexing system.

The Rejection Of Claim 7 On Rindfuss Is Overcome

The O.A. rejected independent claim 7 on Rindfuss as having substantially the same limitations as claim 1. Claim 7 has been rewritten as new claim 32 to define patentability over this reference. Applicant requests reconsideration of this rejection, as now applicable to claim 32, for substantially the same reasons, discussed above, as pertain to reconsideration of independent claim 1, rewritten as new claim 14.

The Rejection Of Claim 2 On Rindfuss Is Overcome

Claim 2 has been rewritten as new claim 15. Rindfuss does not disclose any means for presenting a subject or operator with one or more pre-defined event descriptor measurement items that includes a programmable computer having a central processing unit, a storage system, and an output display, because the use of pre-defined event descriptor measurement items is foreign to Rindfuss.

The Rejection Of Claim 3 On Rindfuss Is Overcome

Claim 3 has been rewritten as new claim 16. Rindfuss does not disclose any means for presenting a subject or operator with pre-defined event descriptor measurement items, as the use of pre-defined measurements items is not disclosed in Rindfuss.

The Rejection Of Claims 5 And 11 On Rindfuss Is Overcome

Claims 5 and 11 have been rewritten as new claims 26 and 42. Rindfuss does not disclose any means for digital recording of observed events but rather describes the use of digital correlation information as a "digital record/playback interface."

The Rejection Of Claim 6 On Rindfuss

Claim 6 has been cancelled in view of the coverage afforded by the remaining claims.

The Rejection Of Claim 10 On Rindfuss Is Overcome

Claim 10 has been rewritten as new claim 34. Rindfuss does not disclose any method for using a video display for presenting a subject or operator with pre-defined event descriptor measurement items, as the use of pre-defined measurements items is not disclosed in Rindfuss.

The Rejection Of Claim 13 On Rindfuss Is Overcome

Claim 13 has been rewritten as new claim 44. Rindfuss does not disclose any means for automatically defining segments of recorded material as said subject or operator proceeds from one pre-defined event descriptor measurement item to another because Rindfuss does not disclose any means of utilizing pre-defined event descriptor measurement items.

The Claims Rejection Under § 103

Claims 4, 8-9, and 12 were rejected under § 103 as being unpatentable over Rindfuss as applied to claims 1 and 7, and further in view of Ardis et al. Applicant requests reconsideration and withdrawal of these rejections.

Rindfuss And Ardis Do Not Contain Any Justification To Support Their Combination, Much Less In The Manner Proposed.

With regard to the proposed combination of Rindfuss and Ardis, it is well known that in order for

any prior-art references themselves to be validly combined for use in a prior-art § 103 rejection, the references themselves must suggest that they be combined. E.g., as was stated in In re Sernaker, 217 U.S.P.Q 1, 6 (CAFC 1983):

“[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.”

That the suggestion to combine the references should not come from the applicant was stated in Orthopedic Equipment Co. V. United States, 217 U.S.P.Q 193, 199 (CAFC 1983):

“It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO].”

As was further stated in Uniroyal, Inc. V. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (CAFC 1988), “[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. ... Something in the prior art must suggest the desirability and thus the obviousness of making the combination.”

In line with these decisions, recently the Board stated in Ex parte Levengood, 28 U.S.P.Q.2d 1300 (P.T.O.B.A.&I. 1993):

“In order for establish a *prime facie* case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive, or inference in the applied prior art, or in the form of readily available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of

the applied references in the proposed manner to arrive at the claimed invention. ... That which is within the capabilities of one skilled in the art is not synonymous with obviousness. ... That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the reference to make the claimed invention. ... Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prime facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that 'would lead' that individual 'to combine the relevant teachings of the references.' ... Accordingly, an examiner cannot establish obviousness by locating references which describe various parts of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done."

In the present case, there is no reason given in the last O.A. to support the proposed combination, other than the statement that "It would have been obvious ... to modify the teachings of Rindfuss with the teachings of Ardis ..." (p. 6). No other explanation of the modification or combination is given.

Applicant therefore submits that combining Rindfuss and Ardis is not legally justified and is therefore improper. Thus applicant submits that the rejection on these references is also improper and should be withdrawn.

Applicant respectfully requests, if the claims are again rejected upon any combination of references, that the Examiner include an explanation, in accordance with M.P.E.P. § 706.02, Ex parte Clapp, 27 U.S.P.Q. 972 (P.O.B.A. 1985), and Ex parte Levingood, *supra*, a "factual basis

to support the conclusion that it would have been obvious" to make the combination.

Even If Rindfuss And Ardis Were to Be Combined In The Manner Proposed, The Proposed Combination Would Not Show All Of The Novel Features Of The Claims

However, even if the combination of Rindfuss and Ardis were legally justified, claims 4, 8-9, and 12, rewritten as claims 16, 35, and 45, have novel and unobvious features over the proposed combination. In other words, applicant's invention, as defined by these claims, comprises much more than simply using an video or computer display for playing and displaying to the user what is being recorded.

In addition, if the invention were in fact obvious, because of its advantages, those skilled in the art surely would have implemented it by now. That is, the fact that those skilled in the art have not implemented the invention, despite its advantages, indicates that it is not obvious. It is noted that the invention is classified in a crowded art; therefore, the invention represents a significant advance and advantages. Furthermore, the invention solves a long-felt, long-existing, but unsolved need for the efficient generation of meaningful indica.

Specifically, claim 16 clearly distinguishes applicant's invention from any possible combination of Rindfuss and Ardis, since neither Rindfuss or Ardis disclose use of pre-defined measurement items.

The Novel Features Of Claim 35 Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over These References Under § 103

Applicant submits that the novel features of claim 35 are also unobvious and hence patentable Under § 103 since it produces new and unexpected results over Rindfuss and Ardis, or any

combination thereof.

These new and unexpected results are the ability of applicant's invention to allow an assessor, through actions taken, to present pre-defined measurement items to a subject of observation and assessment, facilitating an interview or other type of observation and assessment, and allowing the assessor to concentrate upon the behavior of the subject or other aspects of observation and assessment while interacting with the subject. This in turn results in more complete and better quality assessment. Applicant's system therefor is superior to that of either Rindfuss or Ardis, or any possible combination thereof. The novel and unobvious features of applicant's method which effect these differences are, as stated, clearly recited in claim 35.

Claim 45 further discloses "... recording address data is automatically appended to an existing index item entry when said subject or operator returns to a pre-defined event descriptor measurement item one or more times in the course of assessing or describing observed events." Again, this is clearly foreign to Rindfuss and Ardis.

The Dependent Claims Are A Fortieri Patentable Over Rindfuss And Ardis

The new dependent claims 15-31 incorporate all the subject matter of claim 14 and add additional subject matter which makes them a fortieri and independently patentable over these references.

Claim 20 recites:

"An observation and assessment system according to claim 14 wherein said pre-defined event descriptor measurement items include one or more of text components, graphical objects, or video objects."

This is entirely foreign to Rindfuss and Ardis, or any combination thereof since, as stated, the systems of these references do not use and pre-defined measurement items.

Claims 20 and 22 additionally recite:

“An observation and assessment system according to claim 14 wherein said pre-defined event descriptor measurement items include one or more rating scales.”

“An observation and assessment system according to claim 20 wherein said rating scales employ quantitative ratings.”

This is entirely foreign to Rindfuss and Ardis, or any combination thereof since, as stated, the systems of these references do not use pre-defined measurement items, much less use one or more rating scales.

Claim 22 recites:

“An observation and assessment system according to claim 14 wherein said set of pre-defined event descriptor measurement items contains or is based upon an established survey, questionnaire, examination plan, report form, or other assessment instrument.”

This is entirely foreign to Rindfuss and Ardis, or any combination thereof since, as stated, the systems of these references do not use pre-defined measurement items, much less use those containing or based upon established materials.

Claim 23 recites:

“An observation and assessment system according to claim 14 wherein said set of pre-defined event descriptor measurement items is created and stored by a user prior to use in said observation and assessment.”

This is foreign to Rindfuss and Ardis, or any combination thereof since, as stated, the systems of these references do not use pre-defined measurement items, much less use those created and stored by a user prior to observation and assessment.

Claim 30 recites:

“An observation and assessment system according to claim 14 wherein re-assessment of said recorded event data is carried out using said set of pre-defined event descriptor measurement items.”

This is foreign to Rindfuss and Ardis, or any combination thereof since, as stated, the systems of these references do not use pre-defined measurement items, much less support use of said measurement items for re-assessment.

Claim 31 recites:

An observation and assessment system according to claim 14 wherein comparison of assessment results across or within observation subjects is substantially enhanced by use of said set of pre-defined event descriptor measurement items.

This is foreign to Rindfuss and Ardis, or any combination thereof since, as stated, the systems of these references do not use pre-defined measurement items, much less support comparison of assessment results across or within observation subjects.

Similar arguments pertain to the new dependent claims 33-47 of claim 32.

Accordingly, applicant submits that the dependent claims are a fortiori patentable and should also be allowed.

Conclusion

For all of the reasons given above, applicant submits that the specification has been clarified and claims are now in proper form, and that the claims all define patentably over the prior art.

Therefore applicant submits that this application is now in condition for allowance, which action applicant respectfully solicits.

Conditional Request For Constructive Assistance

Applicant has amended the specification and claims of this application so that they are proper, definite, and define novel structure which is also unobvious. If, for any reason this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P § 2173.02 and § 707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible and without need of further proceedings.

Very respectfully,



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